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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/660,063	09/11/2003	Margaret A. R. Beynon	GB920020082US1	6190

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IBM Corporation
IP Law Department
11400 Burnet Road
Austin, TX 78758

02/23/2007

EXAMINER

NUNEZ, JORDANY

ART UNIT	PAPER NUMBER
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2179

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/23/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/660,063

Applicant(s)

BEYNON ET AL.

Examiner

Jordany Núñez

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-31 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. ____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____ |

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DETAILED ACTION

Claim Objections

Claims 1 and 15 are objected to because of the following informalities: "Apparatus for adding" (claim 1, line1) should be changed to --An apparatus for adding--. "Method for adding" (claim 15, line1) should be changed to --A method for adding--. Appropriate correction is required.

Claim Rejections - 35 USC § 112

Claims 15-25, 27-29 are rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling. "[R]eflecting any changes in said transcript on the display screens" (claim 26), is a critical or essential to the practice of the invention, but not included in the claim(s). See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976). In the specification, page 8, line 30 through page 9, line 9, applicant states "information is then forwarded onto client 40 for display of that client's instant messaging software." This demonstrates that this particular feature was considered essential by the applicant, but not reflected in the claims which are rejected because if the information is not displayed then users of clients 10 and 40 would not be able to use the information received to add to the chat transcript (page 9, lines 7-9) since they would not be able to determine what the information received was.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 15-29 are further rejected under 35 U.S.C. 101 because the claimed invention lacks patentable utility. Independent claims 15, 29-~~34~~ recite limitations (e.g., "receiving a message", "analysing the text", etc) for which the end result are neither tangible (e.g., "real world result"); nor concrete (e.g.,

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"repeatable"). The limitations recited (e.g., "receiving a message", "analysing the text", etc) result in manipulation of data, and as such, lack utility. The useful, tangible, and concrete end result must be either explicitly claimed, or inherent in light of the specification or the knowledge of one of ordinary skill in the art. Furthermore, examiner sees no transformation of a physical object in the claimed limitations. See MPEP 2106.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 2, 7, 8, 13, 15, 16, 21, 22, 27, 29-31 are rejected under 35 U.S.C. 102(e) as being anticipated by Okada et al. (US7099867, hereinafter Okada).

As to claims 1, 15, 29-31:

Apparatus, method, computer program, client and server for adding context to a chat transcript, comprising:

means for receiving a message, defining at least a part of said chat transcript, from a user (column 4, lines 60-67);

means for analysing the text of said message (column 5, lines 1-6);

means, responsive to analysis of the text, for modifying said text in order to add context thereto (column 7, lines 32-41);

and means for transmitting said modified message to interested parties (figure 7, top).

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As to claims 2, 16:

wherein said means for modifying the text in order to add context thereto comprises: means for assigning (Examiner reads as –identifying–) a verb (e.g., patent, meeting) to the text (column 12, lines 27-34);

and means for associating the verb with the user from which the message is received (column 4, lines 53-59).

As to claims 7, 21:

wherein said means for modifying the text in order to add context thereto comprises: means for defining how the text should be displayed at a client according to at least one predefined rule (column 7, lines 32-41).

As to claim 8, 22:

comprising: means for instructing said client how to display said text, based upon at least one predefined rule (column 7, lines 32-41).

As to claims 13, 27:

comprising: means for informing a user to whom the text belongs of the suggested context (column 7, lines 18-25);

means for receiving acceptance or rejection of said suggested context (column 7, lines 11-15);

and means for acting upon said rejection or acceptance (column 7, lines 15-25).

References to specific columns, figures or lines should not be limiting in any way. The entire reference provides disclosure related to the claimed invention.

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The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 3, 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Okada.

As to claims 3, 17:

Okada shows an apparatus and method substantially as claimed, as specified above.

Okada further shows: wherein the means for assigning a verb to the text comprises: means for looking for matches between at least a portion of the text and at least one list (figure 3, element s212 and s222), each item in a list being associated with at least one **keyword** (column 4, lines 50-53), and means for selecting (e.g., by lowering by 1 degree) a verb associated with a matched item (column 12, lines 27-34).

Okada fails to specifically show: each item in a list being associated with at least one **verb**.

It would have been obvious to one of ordinary skill in the art, having the teachings of Okada at the time that the invention was made, to have included each item in a list being associated with at least one **verb** with the apparatus and method as taught by Okada.

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One would have been motivated to make such combination because a way to give a higher degree of importance to a verb to which the user frequently responds, and a lower degree of importance to a verb to which a user less frequently responds would have been obtained and desired, as inherently taught by Okada (column 4, lines 28-32).

Claims 4, 5, 18, 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Okada in view of Gruen et al. (US6393460, hereinafter Gruen).

As to claims 4, 5, 18, 19:

Okada shows an apparatus and method substantially as claimed, as specified above.

Okada further shows: wherein associated verbs are assigned weightings which determine how often said verbs are assigned by said assigning means (column 12, lines 51-60)

Okada fails to specifically show: wherein a plurality of verbs are associated with at least one item in at least one list.

In the same field of invention, Gruen teaches: a method and system of informing users of on-line chats subjects. Gruen further teaches: wherein a plurality of **keywords** are associated with at least one item in at least a list (column 6, lines 42-49).

Thus, it would have been obvious to one of ordinary skill in the art, having the teachings of Okada and Gruen at the time that the invention was made, to have combined the plurality of **keywords** being associated with at least one item in at least a list of Gruen with the apparatus and method as taught by Okada.

One would have been motivated to make such combination because a way to picking semantically meaningful words in the process of labeling chats, in spite of a potentially very large number of spelling mistakes, would have been obtained and desired, as expressly taught by Gruen (column 6, lines 42-49).

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Claims 6, 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Okada in view of Akinson et al. (US6507726, hereinafter Akinson).

As to claims 6, 20:

Okada shows an apparatus and method substantially as claimed, as specified above.

Okada further shows: the keyword may be visually displayed, in accordance with the degree of importance, in any of different colors and/or by different types of characters (column 7, lines 18-23).

Okada fails to specifically show wherein the means for assigning a verb to the text comprises: means for replacing at least a portion of the text with said verb.

In the same field of invention, Akinson teaches: a computer implemented education system using chat rooms. Akinson further teaches: wherein the means for assigning a verb to the text comprises: means for replacing at least a portion of the text with said verb (figure 11, "JackS says", "PamK asks", etc).

Thus, it would have been obvious to one of ordinary skill in the art, having the teachings of Okada and Akinson at the time that the invention was made, to have combined the means for assigning a verb to the text comprises: means for replacing at least a portion of the text with said verb of Akinson with the apparatus and method as taught by Okada.

One would have been motivated to make such combination because a way to contribute collateral curricula materials to primary curricula available would have been obtained and desired, as expressly taught by Akinson (column 1, lines 28-30).

Claims 9, 10, 14, 23, 24, 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Okada in view of Kurlander (US6069622)

As to claim 9, 10, 14, 23, 24, 28:

Okada shows an apparatus and method substantially as claimed, as specified above.

Okada further shows: an IRC window is displayed may be modified to indicate the occurrence of the keyword (e.g., assigning context based on a predetermined theme) (column 7, lines 26-28).

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Okada fails to specifically show: comprising means for a user to indicate their mood, means for using said indicated mood to influence the context added to said text, means for including an adverb as part of said context, said adverb chosen according to the mood indicated by the user, and comprising means for assigning context based on a predetermined theme.

In the same field of invention, Kurlander teaches: comic panel generation based on input of text. Kurlander further teaches: comprising means for a user to indicate their mood (column 9, lines 47-52), means for using said indicated mood to influence the context added to said text (column 9, lines 54-56), means for including an adverb as part of said context, said adverb chosen according to the mood indicated by the user (column 10, lines 26-32), and a male character stating that he is from Ohio, the word "Ohio" being a predefined trigger word, and a system modifying the background to show a map of Ohio (e.g., assigning context based on a predetermined theme) (column 8, lines 47-51).

Thus, it would have been obvious to one of ordinary skill in the art, having the teachings of Okada and Kurlander at the time that the invention was made, to have combined the comprising means for a user to indicate their mood, means for using said indicated mood to influence the context added to said text, and means for including an adverb as part of said context, said adverb chosen according to the mood indicated by the user of Kurlander with the apparatus and method as taught by Okada.

One would have been motivated to make such combination because a way to aid a user gain a complete picture of a chat session would have been obtained and desired, as expressly taught by Kurlander (column 2, lines 14-16).

Claims 11, 12, 25, 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Okada in view of Miyashita (US20030154250).

As to claims 11, 12, 25, 26:

Okada shows an apparatus and method substantially as claimed, as specified above.

Okada fails to specifically show: comprising means for storing a history of the chat transcript and comprising means for updating said stored chat transcript; means for reflecting any changes in said transcript on the display screens of users involved in the chat.

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In the same field of invention, Miyashita teaches: a client computer displaying chat log data. Miyashita further teaches: comprising means for storing a history of the chat transcript (page 4, paragraph [0060]) and comprising means for updating said stored chat transcript (page 4, paragraph [0070]); means for reflecting any changes in said transcript on the display screens of users involved in the chat (page 4, paragraph [0072]).

Thus, it would have been obvious to one of ordinary skill in the art, having the teachings of Okada and Miyashita at the time that the invention was made, to have combined the comprising means for storing a history of the chat transcript and comprising means for updating said stored chat transcript; means for reflecting any changes in said transcript on the display screens of users involved in the chat of Miyashita with the apparatus and method as taught by Okada.

One would have been motivated to make such combination because a way to enable a plurality of users to communicate with one another more smoothly would have been obtained and desired, as expressly taught by Miyashita (page 1, paragraph [0006]).

References to specific columns, figures or lines should not be limiting in any way. The entire reference provides disclosure related to the claimed invention.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jordany Núñez whose telephone number is (571)272-2753. The examiner can normally be reached on Monday Through Friday 8am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Weilun Lo can be reached on (571)272-4847. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JN

2/12/2007



WEILUN LO
SUPERVISORY PATENT EXAMINER